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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,321	08/21/2001	Naoya Haneda	09792909-5138	8002
26263 7590 01/02/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			EXAMINER SHANG, ANNAN Q	
			ART UNIT 2623	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/934,321

Applicant(s)

HANEDA, NAOYA

Examiner

Annan Q. Shang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

With respect to claims 1-8, applicant discusses the prior art of record, the claim invention, amends claims and further argues that the prior art of record do not teach the amended claim limitation, i.e., "...an application predetermined by said another device prior to said initial communication..."(see page 5+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes applicant's arguments, however, Tracton teaches that, Client 102 (Another device) identifies an application prior to initial communication and communicates the information to the first device. The client (another device) provides a characteristic profile that enables the server to further determine which application (from the received characteristic profile) to be used by the client to access the content. The client clearly provides application information including format identifying information as it indicates the format that is compatible with the client. Furthermore, when the client requests for data/content from the server, the server provides the client capability-tailored content according to the client's capabilities, which clearly includes application information including format identifying information (col.3, line 40-col.4, line 1+, lines 50-62, col.5, lines 5-65, col.7, line 35-col.8, line 23 and col.9, line 44-col.10, line 29). Hence the amended claims do not overcome the prior art of record as discussed below. The amendment to the claims necessitated the new ground(s) of rejection discussed below. **This office action is made Final.**

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by **Tracton et al (6,470,378)**.

As to claims 1, 4, 7 and 8, **Tracton** discloses an information processing system (100 Fig. 4), corresponding method and computer-readable program for distributing content to another device (102 Fig. 4) via a network (104, 114, 116, Fig. 4) comprising:

First receiving unit (118 in Fig. 4) for configured to receive from the another device (102 Fig. 4), via the network, an initial communication containing information that identifies an application predetermined by the another device prior to the initial communication via which the content can be accessed, content identifying information and format identifying information (col.3, line 40-col.4, line 1+, lines 50-62, col.5, lines 5-65, col.7, line 35-col.8, line 23 and col.9, line 44-col.10, line 29), note that server 70, client 72 and central registry 74 of figure 3 are in communication over a network to determine client's capabilities prior to the actual data is provided to the client (col.3, line 66 – col.4, line 14) of application information (application information 112 in figure 4)

that identifies an application via which the content can be accessed, content identifying information and format identifying information (col.4, lines 14-30);

Reading unit (118 Fig. 4) configured to retrieve from storage said content based on content identifying information included in the information received by the first receiving unit (the reading means is embedded in the receiving means column 5 lines 30-37);

Format converting unit configured to convert the content read by the reading means into data in a predetermined format based on format identifying information included in the received information (col.5, lines 58-62); and

Distributing unit configured to distribute the content, which is converted into the data in the predetermined format by the format converting means, to the another device via the network (col.3, line 40-col.4, line 1+, lines 50-62, col.5, lines 5-65, col.7, line 35-col.8, line 23 and col.9, line 44-col.10, line 29).

As for claim 4, Tracton discloses the format identifying information that includes information, which designates an encoding system and/or encoding rate of the content (the server scales content according to the clients network speed which means it alters the encoding rate to be client specific, col.5 lines 58-62).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tracton** in view of **Shah-Nazaroff et al (6,157,377)**.

As to claim 2, Tracton fails to specifically teach a second receiving unit configured to receive transaction information of the content; authenticating unit configured to authenticate the transaction information when the transaction information of the content is received by the second receiving unit, wherein the reading means reads out the content based on a result authenticated by the authenticating means.

In an analogous art, **Shah-Nazaroff** discloses a second receiving (320 Fig. 3) unit configured to receive transaction information of the content (col.5 lines 25-29); authenticating unit configured to authenticate the transaction information when the transaction information of the content is received by the second receiving unit, wherein the reading unit reads out the content based on a result authenticated by the authenticating unit (password, column 5 lines 13-20).

Hence it would have been obvious to one of ordinary skill in the art to modify Tracton's system to include a second receiving means for receiving transaction information of the content and authenticating means for authenticating the transaction information when the transaction information of the content is received by the second receiving means,' wherein the reading means reads out the content based on a result authenticated by the authenticating means, as taught by Shah-Nazaroff, for the benefit of allowing the system to keep track and securely and accurately bill user upgrade

transactions.

As to claim 3, Tracton fails to specifically disclose a system wherein the transaction information includes a credit card number.

In an analogous art, Shah-Nazaroff discloses a system wherein the transaction information includes a credit card number (col.5 lines 25-27).

Hence it would have been obvious to one of ordinary skill in the art to modify Tracton's system to include transaction information that includes a credit card number, as taught by Shah-Nazaroff, for the benefit of allowing the service provider to bill the users credit card.

As to claim 5, Traction fails to specifically disclose calculating unit configured to calculate a use charge for the content based on the application information, which is received by the first receiving unit;
and accounting unit configured to account the use charge, which is calculated by the calculating unit, corresponding to the other device.

In an analogous art Shah-Nazaroff discloses calculating unit configured to calculate a use charge for the content based on the application information which is received by the first receiving unit (the system bills upgrades which is additional content features such as stereo instead of Mono, HDTV instead of lower resolution TV, which means the system has the ability to calculate the amount to charge a user depending on the upgrades that he/she have selected, col.5 lines 25-28);
and accounting unit configured to account the use charge, which is calculated by the calculating unit, corresponding to the other device (client accounts, col.5 lines 25-28).

Hence it would have been obvious to one of ordinary skill in the art to modify Tracton's system to include a unit for calculating a use charge for the content based on the application information which is received by the first receiving unit and accounting unit for accounting the use charge, which is calculated by the calculating unit, corresponding to the other device, as taught by Shah-Nazaroff, for the benefit of allowing the service provider to keep accurate records of a large number and charge those users based on the amount of upgrades they elect to use.

As for claim 6, Tracton fails to specifically teach a detecting unit configured to detect a busy status on the network, wherein the format converting unit converts the content into data in a predetermined format based on the busy status, which is detected by the detecting unit.

In an analogous art, Shah-Nazaroff discloses detecting unit configured to detect a busy status on the network, wherein the format converting unit converts the content into data in a predetermined format based on the busy status which is detected by the detecting unit (the greater the number of users on the network, the lower the video quality the each subscriber receives from the broadcast network column 2 lines 30-38).

Hence it would have been obvious to one of ordinary skill in the art to modify Tracton's system to include a detecting unit configured to detect a busy status on the network, wherein the format converting unit converts the content into data in a predetermined format based on the busy status which is detected by the detecting unit, as taught by Shah-Nazaroff, for the benefit of making sure that there is enough

available bandwidth on the network to support the broadcast streams being sent to the users.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone

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number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

Annan Q. Shang